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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,309	04/14/2004	Christopher C. Capelli	BITI-08569	5983

7590 09/01/2005

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,309

Applicant(s)

CAPELLI, CHRISTOPHER C.

Examiner

JOHN PAK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 19-25 is/are rejected.
- 7) ☒ Claim(s) 8-18 and 26-28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/14/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

Claims 1-28 are pending in this application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/13116.

WO 99/13116 explicitly discloses contacting a silver thiosulfate solution with an ion exchange resin with an amine functionality (page 7, lines 21-31). The ion exchange resin can be in the form of beads (page 8, lines 26-27; page 10, lines 13-14). Broad particle size of the ion exchange resin is disclosed (paragraph bridging pages 10-11), including “at least about 0.8 mm in average diameter” (page 14, lines 1-2). Polystyrene-divinyl benzene resins with amine functionality are disclosed as suitable resins (page 11, lines 12-15). Amine functional group such as triethylamine and triethyl ethanolamine are disclosed (page 12, line 26; page 14, line 3). Commercial anionic resins such as Dowex MSA-2, gel type resin 21K, Amberlite IRA-910, Lewatit M-600 and MP 500 are disclosed (page 14, lines 1-11) - it is noted that these resins are the same as the anionic resins disclosed by applicant on specification page 19.

Claims 5 and 23 are included in this ground of rejection, because, upon further review, it appears that “less than approximately 0.8 mm” is broad enough to encompass 0.8 mm,

which is expressly disclosed by the cited reference. The claims are thereby anticipated, since the anticipation of the remaining claims are plainly evident from the above discussion.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/13116 in view of The Merck Index.

WO 99/13116 explicitly discloses contacting a silver thiosulfate solution with an ion exchange resin with an amine functionality (page 7, lines 21-31). The ion exchange resin can be in the form of beads (page 8, lines 26-27; page 10, lines 13-14). Broad particle size of the ion exchange resin is disclosed (paragraph bridging pages 10-11), including "at least about 0.8 mm in average diameter" (page 14, lines 1-2). Polystyrene-divinyl benzene resins with amine functionality are disclosed as suitable resins (page 11, lines 12-15). Amine functional group such as triethylamine and triethyl ethanolamine are disclosed (page 12, line 26; page 14, line 3). Commercial anionic resins such as Dowex MSA-2, gel type resin 21K, Amberlite IRA-910, Lewatit M-600

and MP 500 are disclosed (page 14, lines 1-11) - it is noted that these resins are the same as the anionic resins disclosed by applicant on specification page 19. All commercial strong-base resins having triethylamine functional group or triethyl ethanolamine functional group are disclosed (page 14, lines 2-11).

The Merck Index discloses cholestyramine resin as a strong basic anion exchange resin having polystyrene trimethylbenzylammonium and divinylbenzene structure (page 369, item no. 2257).

The difference between the claims and the primary reference by WO 99/13116 is that the primary reference does not explicitly disclose the feature of cholestyramine as the anion exchange resin. However, the primary reference discloses anion exchange resins with an amine functionality such as triethylamine functional group. Polystyrene-divinyl benzene resins with an amine functional is clearly taught. As a result, one having ordinary skill in the art would have been motivated to utilize similar ion exchange resins. Given that cholestyramine is a good anion exchange resin having polystyrene trimethylbenzylammonium and divinylbenzene structure, the ordinary skilled artisan would have been motivated to select cholestyramine as an exchange resin, in accordance with the teachings of the primary reference.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because

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every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

Applicant is advised to substitute "so" for "such" in claim 16, line 5, in order to remove any ambiguity that may arise due to "such," i.e. in order to clarify whether "such" operates as an exemplary or limiting term.

Claims 8-18 and 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable, *subject to the above change and a search update at the time of the next Office action*, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

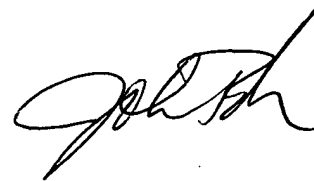
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK
PRIMARY EXAMINER
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